UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,632	05/14/2001	Bradley J. Florin	1261.03	8724

21901   7590   09/24/2004

SMITH & HOPEN PA
15950 BAY VISTA DRIVE
SUITE 220
CLEARWATER, FL 33760

EXAMINER
LE, KHANH H

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/681,632	FLORIN, BRADLEY J.
	Examiner	Art Unit	
	Khanh H. Le	3622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *5/14/2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) *16-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *16-19* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *6/14/01*

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

Detailed Action

1. This Office Action is responsive to the original Application.

Claims Objections

2. Many typographical errors are found.

Apparently, there are 2 claims labeled 8. The second one should be claim 9.

Now labeled claims 9-13, should be relabeled 10-14, , respectively.

There seems to be missing a claim label which should be claim 15 and which is now dependent on claim 14.

Now labeled claim 14 should be claim 15.

Now labeled claim 15 should be relabeled 17 and be dependent on claim 16.

Now labeled claim 16 should be relabeled 18.

Now labeled claim 17 should be relabeled 19 and be dependent on claim 18.

The last claim should be labeled claim 20.

Appropriate corrections are required.

The Examiner has relabeled the claims for examination purposes only.

Claim 14. (Now labeled claim 13) should read "

...establishing a conference system, the system having a plurality of conference areas;

establishing a conference feature communicatively coupled to the application;

associating at least one predetermined conference area with the use of the skin."

(per telephone conversation with Mr. Hopen, Applicant's representative, on 9/8/04).

Appropriate correction is required.

Election/Restrictions

3.   During a telephone conversation with Mr. Hopen, Applicant's representative, on 9/8/04, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-15, and 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-19 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

I.   Claims 1-15, 20 , drawn to a method of obtaining demographic information relating to the use of a user computer software application, classified in class 705, subclass 14.

II.   Claims 16-19, drawn to a method and computer program for authoring a skin with embedded demographic information, classified in class 709, subclass 221.

5.   The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as the providing of ads based on the skin aesthetics while invention II has the separate utility of the demographics being embedded in the skin whereby intellectual rights may be premised upon. See MPEP § 806.05(d).

Claim interpretation

6.   As to claims 1, 6, 10, 20, it is interpreted that the claims involve being
responsive to the use of the "skin",(with "skin" defined according to the specifications, at
page 1, paragraph [0004]) and thus imply the use of computer software technology.   35
U.S.C. 101 issues are thus not raised.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for
all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed*
> *or described as set forth in section 102 of this title, if the differences between the*
> *subject matter sought to be patented and the prior art are such that the subject*
> *matter as a whole would have been obvious at the time the invention was made to*
> *a person having ordinary skill in the art to which said subject matter pertains.*
> *Patentability shall not be negatived by the manner in which the invention was*
> *made.*

8.   **Claims 1-15, 20 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Hoyle, US 6141010, herein Hoyle, in view of Burge et al., US
6014638 A, herein Burge.**

Hoyle discloses a method and apparatus for providing a software application that
instantly provides targeted advertising based upon demographics as well as user
interactions with the computer such as selection of programs like spreadsheets.

Thus as to claims 1-3, 6, 11-13, 20, Hoyle discloses

A method of obtaining anonymous (see at least col. 7 lines 26-45, Fig. 8 and associated text)

demographic information relating to the use of a user computer software application, the method comprising the steps of:

establishing a client-side software application usage monitoring application adapted to detect the presence of at least one skin on a client-side computing device;

establishing a demographic data store communicatively coupled to the client-side skin monitoring application (see at least Figs. 3, 8 and associated text);

establishing an identity of at least one skin on the client-side computing device through the client-side monitoring application see at least col. 17 lines 26-45)

;

and transmitting the identity of the at least one skin to the demographic data store (see at least col. 17 lines 26-45)

retrieving an array of demographic information responsive to the registration of a client-side application (see at least Figs. 10, 12 and associated text; col. 2 lines 43-60);

storing the array in the data store (see at least Figs. 10, 12 and associated text);

responsive to a use of the software application, establishing a data connection between the data store and the application (see at least Figs. 3, 8 and associated text) ;

updating the array to reflect the use of the user software application (see at least Figs. 3, 8 and associated text);

aggregating a plurality of arrays which reflect the use of the user software application (see at least col. 7 lines 26-45);

resolving a common demographic profile associated with the user software application (see at least col. 7 lines 26-45); and

sending demographically targeted content to the application responsive to the use of the user software application (see at least col. 1 lines 43-47);

Hoyle does not specifically disclose one of the user applications monitored is a skin.

However, Burge discloses a predictive model to deduce profiles from navigational/ graphical selections of the user such as selections of background colors, music and sounds, options, shapes, background items, etc.. to send targeted content and content display characteristics. (see at least abstract, col.8 lines 21-48). Official Notice is taken that skins or screensavers are made up of aesthetics such as colors, sizes and shapes. Thus it would have been obvious to one skilled in the art at the time the invention was made to use skins as sources of user preferences to target ads as used in Burge. Further, it would have been obvious to one skilled in the art at the time of the invention to add Burge's targeting based on skins aesthetics preferences, as discussed above to Hoyle to target content and content display characteristics as taught by Burge.

Further since a screensaver is merely one type of software normally found on a user's computer, it would have been obvious to one skilled in the art at the time the invention was made to add screensavers to Hoyle's teachings, to expand the list of computer programs based on which ads can be tailored reactively, as taught by Hoyle (see abstract).

As to claims 4 and 14 (dependent on claims 1 and 11, respectively), Hoyle discloses a notes module to communicate among many users (see at least col. 12 line 47-col. 13 lines 10) thus Hoyle discloses establishing a conference system, the system having a plurality of conference areas; establishing a conference feature communicatively coupled to the application.

Hoyle also discloses associating at least one predetermined conference area with the use of a particular user action (see at least col. 12 lines 54-58: the particular subject matter of the note, e.g. sports related is considered a "predetermined conference area" which is shown, based on a second user's action such as clicking on a sports webpage) , Hoyle does not specifically disclose the user action is the selection of a skin , however it would have been obvious to one skilled in the art at the time the invention was made to modify Hoyle's clicking on a sports website to trigger the note (the "predetermined conference area") with clicking to select a skin because both actions allow deducing user demographics based on which targeted messages (notes) are sent.

As to claims 5 and 15 (dependent on claims 4 and 14) Hoyle also discloses defaulting to the at least one predetermined conference area responsive to an execution of the conference feature and the use of a particular action (see at least col. 12 line 47- col. 13 lines 10). The modification of Hoyle to include the use of a skin is as explained in claims 4 and 14 above.

As to claim 7 (dependent on claim 6), it is admitted third-party skin applications such as the NeoPlanet web browser, the WinAmp music player, or the like are well-known (Specifications at paragraph [0040]).Thus it would have been obvious to one skilled in the art at the time the invention was made to add such admittedly known skins, enabled on a third-party skinable application, to Hoyle/Burge because they are readily available.

As to claims 8-10 (dependent on claim 6) Official Notice is taken that monitoring internal operating system messaging , preselecting an array of file directories to and on a client-side storage device to detect the use of an application are common and efficient ways of detecting such uses. Thus it would have been obvious to one skilled in the art at the time of the invention to add and take advantage of these well-known techniques to Hoyle/Burge to effect detecting the skin application.

Conclusion

9.   Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PROFILE: POINTCAST DOMINATES INTERNET BROADCAST MARKET,
Internet Week, v2, n31, pN/A, August 5, 1996, DIALOG(R)File 636, Record #
03221406, discloses customized /targeted screen savers showing information including news, sports, entertainment, weather, and stock tickers (see 3rd full paragraph).

Kobata, US 6058418, discloses a system and client-side software having a unique serial number to
detect demographics of a client including CPU power, hard disk space,
identities of applications installed and run, network connectivity and log-in history to automatically send targeted content and format of content (see at least Figs 4, 5; col. 5 lines 1-16 , col. 3 lines 1-27),. The demographics database is built and updated.

Dedrich, US 5752238 A, discloses user profiles, made up of preferences such as <u>color</u> preferences, favorite sizes and shapes, are used for targeted content and content display characteristics.

Reilly et al, US 5740549 discloses targeted ads delivered thru a screensaver (see at least Fig. 6 and associated text ; col. 5 lines 1-45).

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.
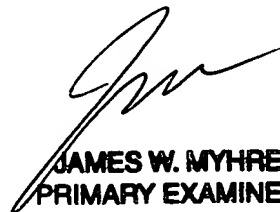
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

September 13, 2004

KHL

JAMES W. MYHRE
PRIMARY EXAMINER